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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/528,645 | 11/18/2005 | Frank Brady | PH0274 | 7017 |
| 36335 7590 08/14/2007 GE HEALTHCARE, INC. IP DEPARTMENT 101 CARNEGIE CENTER PRINCETON, NJ 08540-6231 | | | | |
| | | | EXAMINER WITHERSPOON, SIKARL A | |
| | | | ART UNIT 1621 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/528,645

Applicant(s)

BRADY ET AL.

Examiner

Sikarl A. Witherspoon

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/21/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4-6 depend from claim 1, and recite formula (Ia); however, claims 1 does not recite formula (Ia), thereby rendering the claims indefinite.

Claims 4-6 are further indefinite for reciting the use of a compound of formula (I or Ia), but failing to recite any process steps related to said use.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131

USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation "a source of F-", and the claim also recites "preferably ¹⁸F-" which is the narrower statement of the range/limitation.

Claim 7 is also indefinite for depending from claim 1, and reciting formula (IIa); claim 1 does not refer to any compound of formula (IIa).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by CAPLUS AN#'s 1994:30806, 1977:42771, 1976:150698, and 1978:121329.

The compounds disclosed on these abstracts anticipate the instant claims.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by CAPLUS AN#'s 1999:304473, 1996:446320, and 1998:352139.

The compounds disclosed on these abstracts anticipate the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1621

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pukhnarevich et al (Collection of Czech. Chem. Communic., 1974) and/or Vcelak et al (Collection of Czech. Chem. Communic, 1976).

The instant claims are drawn to the preparation of a fluorosilane compound by reacting a silane compound with a source of fluoride ion in the presence of a phase transfer agent.

Both reference teach such a reaction, using a metal halide fluorinating agent, such as potassium fluoride. The difference is that said references do not teach the use of a phase transfer agent. However, this does not constitute a patentable limitation of the instant claim or the prior art. The examiner contends that while not explicitly taught by either reference, it would have been obvious to a person having ordinary skill in the art to add a phase transfer agent to the process taught by Pukhnarevich et al or Vcelak et al, since a person of ordinary skill would have recognized that the compound(s) used as fluoride ion source, i.e., potassium fluoride, would not have readily dissolved in the organic solvent conditions employed in the reference(s). Such a person would therefore have been motivated to employ a phase transfer agent such as a crown ether, which is a class of well-known macrocyclic phase transfer agents.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over CAPLUS AN#'s 1994:30806, 1977:42771, 1976:150698, and 1978:121329.

Art Unit: 1621

The instant claim recites a compound similar to the compound recited in instant claim 8, the difference being that the fluorine attached in the compound of the instant claim is 18-fluorine.

The instant claim is rendered obvious over the above listed references since said references disclose the same compounds, but with normal fluorine, 19-Fluorine. It would have been obvious to a person of ordinary skill in the art to exchange 19-Fluorine taught said references, with 18-Fluorine, since it is well-known in the art that using 18-Fluorine in biomolecules containing fluorine is an important noninvasive technique for studying living tissue by positron emission topography.

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter: the process recited in claims 1 and 2 is not taught or suggested by closest prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sikarl A. Witherspoon whose telephone number is 571-272-0649. The examiner can normally be reached on M-F 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

saw

Sikarl A. Witherspoon
SIKARL A. WITHERSPOON
PRIMARY EXAMINER